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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/322,174 05/28/99 LANDA

B UCT-A

EXAMINER

IM22/0921

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GROUP	PAPER NUMBER
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1753

DATE MAILED: 09/21/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 54 - 76 is/are pending in the application.
- Of the above, claim(s) 59-60, 64, 68, 72-76 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 54-58, 61-63, 65-67, 69-71, 73-75 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 15
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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1. Claims 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent 62127753A. The Japanese Abstract teaches a metallic toner for electrophotography having metallic flakes, resin and colorant as part of the toner composition. Applicant has shown no critical aspects of the flake size. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize commercial flakes which are within the size range as taught by applicant as the metallic flakes in the metallic toner of Japanese Patent 62127753A.

2. Claims 54-58, 61-63, 65-67, 69-71 and 73-75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent 62127753 in view of Japanese Patents 5242721A, 4183804A, European Patent Application 0184714 and Tsubuko et al. Japanese Patent '753 teaches a metallic toner comprising metallic flakes. Japanese '721 teaches various shapes (note 0013) and the use of silver as the metal. The European patent application teaches also size of particles utilized in a developer for developing latent electrostatic images. Tsubuko et al. teaches the use of ionomers as binders for developers utilized in the electrostatic process and Japanese '804A teaches inorganic particles in a flake form utilizing metals such as gold and silver that can be utilized as electrostatic toners. It would have been obvious to one of ordinary skill in the art at the time

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of applicant's invention with a reasonable expectation of success to utilize known components of developers utilized in developing latent electrostatic images such as ionomers as binders with various metal combinations of silver and gold in various sizes as metallic flakes in Japanese '753 in providing a toner for developing a latent electrostatic image.

3. Claims 54-58, 62, 63, 66, 67, 70, 71, 74 and 75 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement in reference to "dry toner". Applicant's Examples and method of preparing are all directed to liquid toner. Applicant in his response should specifically point out where in the specification reference to a dry toner or the method of making a dry toner is shown.

4. Claims 65, 66 and 67 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement as to what and how an electrofied toner particle is prepared. Applicant in his response should

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specifically point out in the specification where there is a reference to the electrofied toner particle.

5. Applicant should update the specification in reference to any U.S. applications. Note the specification pages 13 and 16.

J. Goodrow:cdc

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August 20, 2001

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JOHN GOODROW
PRIMARY EXAMINER
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